

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD A. SCHROEDER

Appeal No. 1996-3918
Application No. 08/232,351¹

HEARD: August 4, 1999

Before MEISTER, STAAB and McQUADE, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

¹ Application for patent filed April 22, 1994. According to appellant, this application is a continuation of Application No. 08/086,082 filed July 6, 1993, now abandoned; which is a continuation of Application No. 07/950,674 filed September 25, 1992, now U.S. Patent No. 5,279,496 issued January 18, 1994.

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Edward A. Schroeder (the appellant) appeals from the final rejection of claims 1, 3-5, 8, 9, 11-16 and 21, the only claims remaining in the application.

We AFFIRM-IN-PART.

The appellant's invention pertains a basketball backboard and rim which is vertically adjustable by means of a slidable mounting structure. Of special importance is the provision of a means for securing the rim to the backboard, which means includes fasteners that extend through apertures in the slidable mounting structure in such a manner that forces applied to the rim (e.g., by a "slam dunk") may be transmitted directly to the slidable supporting structure via the fasteners, thus protecting the backboard from the forces. Independent claim 1 is further illustrative of the appealed subject matter and copy thereof may be found in the appendix to the brief entitled "CLAIMS ON APPEAL."

The references relied on by the examiner are:

Chervenka	2,916,288	Dec.
8, 1959		
White	4,395,040	Jul. 26,
1983		
Cramblett	4,643,422	Feb.
17, 1987		

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Willard
1990

4,948,127

Aug. 14,

The prior art depicted by the appellant in Fig. 2 and described in the paragraph bridging pages 5 and 6 of the specification. (the prior art of Fig. 2).

The answer states that the following rejections are applicable to the claims on appeal.²

(1) Claims 1, 3-5, 8, 9 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cramblett in view of White.

(2) Claims 1, 3-5, 8, 9, 11-13, 15, 16 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the prior art of Fig. 2 in view of White.

(3) Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over the prior art of Fig. 2 in view of White as applied to claim 13 above, and further in view of Chervenka and Willard.

² In the final rejection the claims on appeal were also rejected under "the judicially created doctrine of double patenting over patent no. 5,279,496" (see page 6). In view of the lack of any mention of this rejection in the answer, we presume that the examiner has withdrawn the final rejection of claims 1, 3-5, 8, 9, 11-16 and 21 on this ground. **See Ex parte Emm**, 118 USPQ 180, 181 (Bd. App. 1957).

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The examiner's rejections are explained on pages 3-7 of the answer. The arguments of the appellant and the examiner in support of their respective positions may be found on pages 4-18 of the brief and pages 3-9 of the answer. As evidence of nonobviousness the appellant has relied on a self-executed declaration and declarations by Maier and Lee.

OPINION

As a preliminary matter, we base our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in the claims. In line 7 of claim 1 we interpret "directly to said slide means" to be -- directly to said center bracket --. Similarly, in line 9 of claim 21 we interpret "directly to said slide [sic]" to be -- directly to said center bracket --.

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner, the evidence of nonobviousness supplied by appellant, and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review, we will sustain

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Rejection (1) and reverse Rejections (2) and (3). Our reasons for these determinations follow.

Considering first Rejection (1), the appellant notes various deficiencies of the references individually and urges that there is no suggestion to combine the teachings of Cramblett and White in the manner proposed by the examiner. We disagree. Cramblett discloses a vertically adjustable basketball backboard and rim structure comprising a support means 18 for mounting the backboard and rim structure to a support 16, guide means 48 connected to the support mounting means, slide means 52, 54 mounted to the guide means, backboard mounting means 66,66',74,74', a center bracket 58,60,62 and drive means 82,92. Cramblett fails to teach providing apertures for connecting the rim through the backboard directly to the center bracket.

White, however, teaches a backboard and rim structure that is vertically adjustable by a parallelogram structure, 12,22,24,28, and a center bracket 44 having apertures therein for the reception of fasteners 45 for connecting the rim through the backboard directly to the center bracket. By such an arrangement White provides

a means of bolting the goal (rim) directly to the supporting frame through the backboard thus providing a stronger unit and minimizing the breaking of the goal from the board by players hanging on the rim. [Column 1, lines 63-68.]

Especially in view of this statement by White, one of ordinary skill in this art would have found it obvious to provide the center bracket 58,60,62 of Cramblett with apertures for the purpose of receiving fasteners in order to connect the rim through the backboard directly to the center bracket and thus achieve White's expressly stated advantages of providing a stronger unit and minimizing the breaking of the goal from the board by players hanging on the rim.

With respect to claims 13 and 21 the appellant argues that the prior art does not show a pair of guides connected adjacent an edge of the support brackets. We must point out, however, that Cramblett in Fig. 1 clearly depicts the guides 48,50 as being adjacent the front edge of brackets 24,26.

With respect to claims 5, 12 and 21 it is also the appellant's contention that the prior art does not show the center bracket being connected directly to, and extending between, a pair of slides. This contention is also not persuasive since the center bracket 58,60,62, of Cramblett

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indeed extends between, and is connected to, the slides 52,54
(see, e.g., Fig. 1).

The appellant additionally argues that the prior art has been available for "a substantial period of time" and this is an indication of nonobviousness. We observe, however, that a mere **21 months** separates the filing date (i.e., March 15, 1985) of Cramblett and the issue date (i.e., July 26, 1983) of White. In any event, the mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem. **See, e.g., In re Wright**, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977).

The appellant also contends that the claimed invention is directed to an improvement in a "crowded art" and, accordingly, even a small improvement should be patentable. Not only is there no evidence of record to support the contention that this is a crowded art but, even if there were, the criterion on which patentability must be resolved is obviousness under 35 U.S.C.

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§ 103. **See *In re Saari***, 386 F.2d 909, 913, 155 USPQ 691, 694 (CCPA 1967). On this basis, we are satisfied that the combined teachings of Cramblett and White establishes a ***prima facie*** case of obviousness with respect to the claims under consideration.

Having arrived at the conclusion that the evidence of obviousness as applied in the rejection of the claims under consideration is sufficient to establish a ***prima facie*** case of obviousness, we recognize that the evidence of nonobviousness submitted by the appellant must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C.

§ 103. ***Stratoflex, Inc. v. Aeroquip Corp.***, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating therewith the objective evidence of nonobviousness and argument supplied by the appellant. **See *In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The declaration by Lee establishes that the declarant (1) has a degree in architecture, (2) has read "the subject

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pending application and the references therein and (3) that, to his knowledge, "no one has, or even suggested modifying the vertical slide structure as is exemplified in . . . Cramblett . . . with a direct mount of the rim to the slide structure" and (4) "[i]t was not obvious to me in September, 1992 to make such a combination." Even if we were to agree that the above-noted credentials establishes the declarant to be an expert in the art, the declaration merely sets forth the conclusory opinion that it would not have been obvious to combine the teachings of the references, rather than facts as to why this might be the case. Affidavits and declarations fail in their purpose when they recite conclusions with few facts to buttress the conclusions. **See *In re Brandstadter***, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973), ***In re Thompson***, 545 F.2d 1290, 1295, 192 USPQ 275, 277-78 (CCPA 1976) and ***In re DeBlauwe***, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Moreover, while it is proper to give some weight to a persuasively supported statement of one skilled in the art on what was not obvious to him or her, obviousness is a question of law which we must decide (**see *In re Weber***, 341 F.2d 143,

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145, 144 USPQ 495, 497 (CCPA 1965) and *In re Vamco Machine and Tool, Inc.*, 752 F.2d 1564, 1574-75, 224 USPQ 617, 623 (Fed. Cir. 1985)), and an expert's opinion on the legal conclusion of obviousness is neither necessary nor controlling (*see Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1564, 7 USPQ2d 1548, 1554 (Fed. Cir. 1988)).

The declaration by Maier establishes that the declarant was the national sales manager for Porter Athletic Equipment Company and states that the attached chart shows sales figures of the "old style" backboard units *vis-à-vis* "our current single support direct mount basketball backboard system (described in . . . attached U.S. Patent No. 5[,]279,496 - the parent of the instant application)." This evidence, however, does not establish the required nexus between the sales figures for the "NEW STYLE" goal mount system and the claimed invention. *See Stratoflex Inc. v. Aeroquip corp., supra*, 713 F.2d 1530, 1539, 218 USPQ 871, 879 (Fed. Cir. 1983) and *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27, 226 USPQ 881, 887-88 (Fed. Cir. 1985). See also *Sjolund v. Musland*, 847 F.2d 1573, 1582, 6 USPQ2d 2020, 2028 (Fed.

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Cir. 1988): "Commercial success is relevant only if it flows from the merits of the **claimed** invention." Here, while the chart showing might possibly be considered to establish that the sales figures for the "NEW STYLE" were better than the "OLD STYLE" since 1994, there is nothing which establishes that the "NEW STYLE" was the invention disclosed and **claimed** in the instant application. Moreover, the sales depicted in the chart have not been placed in a meaningful context, e.g., **total** market share or profitability. In this regard, it should also be noted that "evidence related solely to the number of units sold provides a very weak showing of commercial success, if any." *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1687 (Fed. Cir. 1996). The declaration also states that "[b]ased on my marketing activities I can state that the sales success of the single support system has been because of the feature of the single support adjustable backboard system with the basketball rim goal attached directly to the support member." This statement, however, is simply conclusory in nature and unaccompanied by any

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supporting facts. ***See In re Brandstadter, supra, In re Thompson, supra, and In re DeBlauwe, supra.***

The appellant's self-executed declaration sets forth various problems of the prior art backboards and notes various differences between White and the appellant's "invention," and thereafter states that the invention "satisfies the needs of the institutional market." Apparently, the appellant believes that this evidence establishes long-felt need. However, to establish long-felt need, evidence must be presented which demonstrates the existence of a problem which was of concern in the industry and has remained unsolved over a long period of time. ***See Vandenberg v. Dairy Equipment Co.***, 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984). This can be accomplished, for example, by the testimony of experts in the industry, or publications or the like, which speak to the duration and extent of the problem, and of the substantial effort and resources which had been expended during that time in attempts to solve the problem. ***See Railroad Dynamics, Inc. v. Stuki Co.*** 579 F. Supp. 353, 218 USPQ 618, 628 (E.D. Pa. 1983), ***aff'd*** 727 F.2d 1506, 220 USPQ 929 (Fed. Cir. 1984),

cert. denied 105 U.S. 220 (1984). Once the long-felt need has been established, it must further be shown that the invention satisfied that need. **See *In re Cavanagh***, 436 F.2d 491, 496, 168 USPQ 466, 471 (CCPA 1971). This can be demonstrated, for example, by evidence establishing commercial success and that the industry purchased the claimed invention because it satisfied the long-felt need. **See *W. L. Gore & Associates, Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1555, 220 USPQ 303, 315 (Fed. Cir. 1983), **cert. denied** 105 S. Ct. 172 (1984). When viewed in this context, we are satisfied that the above-noted statements in the appellant's declaration fall far short of establishing long-felt need.

The appellant's self-executed declaration also states that U.S. Patent No. 5,800,296 establishes evidence of copying. However, the mere fact that another person (i.e., Shaw) patented and/or used similar technology is not persuasive evidence that Shaw knew of the appellant's invention and copied it. Shaw might well have independently developed a backboard which falls within the scope of the claimed invention. Moreover, it is well settled that "more

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than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue" because "copying could have occurred out of a general lack of concern for patent property," **Cable Electric Products, Inc. v. Genmark, Inc.**, 770 F.2d at 1028, 226 USPQ at 889.

When all the evidence and argument are considered anew it is our conclusion that, on balance, the evidence and argument presented by the appellant taken as a whole fails to outweigh the evidence of obviousness established by the prior art. **See Newell Cos. v. Kenney Mfg. Co.**, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) and **In re Beattie**, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1043 (Fed. Cir. 1992).

Accordingly, we will sustain the rejection of claims 1, 3-5, 8, 9 and 21 under 35 U.S.C. § 103 as being unpatentable over Cramblett in view of White.

Turning to Rejections (2) and (3), both of these rejections are based on the examiner's view that:

It would have been obvious to provide the vertically movable portion of Fig. 2's [the prior art of Fig. 2] height adjusting mechanism (i.e., the slide means) with a center bracket as claimed with

fastener receiving apertures for mounting the rim directly thereto through the backboard in place of the two outwardly positioned vertical members [54 in view of the teachings of White]. . . . Note that in Fig. 2 the slide means 58 are connected near the top of the vertical members; this same relationship would clearly be retained when a center member is substituted. Further, although the vertical members of Fig. 2 appear to be separated from the slide means by short horizontal spacers (unnumbered), no particular significance is seen in whether the center bracket is connected to the slide means with similar spacers or directly to the slides 58. If the center bracket has a width equal to the spacing between the inner edges of the slides no spacers would be necessary and such an arrangement would eliminate a number of parts resulting in more economical fabrication as there would be fewer parts to assemble. [Answer, pages 5 and 6.]

Apparently, the examiner proposes to (1) provide the prior art of Fig. 2 with a single centrally located vertical bracket (in lieu of the spaced brackets 54) and attach the rim structure to this single central bracket in view of the teachings of White and (2) dismiss the limitation of the bracket being directly attached to the slide means as being of "no particular significance." We will not support the examiner's position. As to proposal (1), we find nothing in the combined teachings of the prior art of Fig. 2 and White which would fairly suggest combining the teachings of these references in the manner proposed. Such a modification would

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result in a total reconstruction of the backboard and rim structure of the prior art of Fig. 2 and, in our view, is based on hindsight. As to proposal (2), obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)) and the examiner may not resort to speculation (e.g., theorizing that a limitation is of "no particular significance") to supply a deficiency in the factual basis (*see In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967)).

With respect to claim 14 (i.e., Rejection (3)), we have carefully reviewed the teachings of Chervenka and Willard but find nothing therein which would overcome the deficiencies of the prior art of Fig. 2 and White that we have noted above.

In view of the foregoing, we will not sustain the rejections under 35 U.S.C. § 103 of claims 1, 3-5, 8, 9, 11-13, 15, 16 and 21 based on the combined teachings of the prior art of Fig. 2 and White (i.e., Rejection (2)) and claim 14 based on the combined teachings of the prior art of Fig. 2, White, Chervenka and Willard (i.e., Rejection (3)).

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In summary:

Rejection (1) is affirmed.

Rejections (2) and (3) are reversed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
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